

## Calendar No. 13

107TH CONGRESS  
1ST SESSION**S. 320**

To make technical corrections in patent, copyright, and trademark laws.

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## IN THE SENATE OF THE UNITED STATES

FEBRUARY 13, 2001

Mr. HATCH (for himself and Mr. LEAHY) introduced the following bill; which  
was read twice and ordered placed on the calendar

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**A BILL**

To make technical corrections in patent, copyright, and  
trademark laws.

1       *Be it enacted by the Senate and House of Representa-*  
2       *tives of the United States of America in Congress assembled,*

3       **SECTION 1. SHORT TITLE.**

4       This Act may be cited as the “Intellectual Property  
5       and High Technology Technical Amendments Act of  
6       2001”.

7       **SEC. 2. OFFICERS AND EMPLOYEES.**

8       (a) RENAMING OF OFFICERS.—(1) Title 35, United  
9       States Code, is amended—

1 (A) by striking “Director” each place it appears  
 2 and inserting “Commissioner”; and

3 (B) by striking “Director’s” each place it ap-  
 4 pears and inserting “Commissioner’s”.

5 (2) The Act of July 5, 1946 (commonly referred to  
 6 as the “Trademark Act of 1946”; 15 U.S.C. 1051 et seq.)  
 7 is amended by striking “Director” each place it appears  
 8 and inserting “Commissioner”.

9 (3)(A) Title 35, United States Code, is amended by  
 10 striking “Commissioner for Patents” each place it appears  
 11 and inserting “Assistant Commissioner for Patents”.

12 (B) Section 3(b)(2) of title 35, United States Code,  
 13 is amended—

14 (i) in the paragraph heading, by striking “COM-  
 15 MISSIONERS” and inserting “ASSISTANT COMMIS-  
 16 SIONERS”;

17 (ii) in subparagraph (A), in the last sentence—

18 (I) by striking “a Commissioner” and in-  
 19 serting “an Assistant Commissioner”; and

20 (II) by striking “the Commissioner” and  
 21 inserting “the Assistant Commissioner”;

22 (iii) in subparagraph (B)—

23 (I) by striking “Commissioners” each place  
 24 it appears and inserting “Assistant Commis-  
 25 sioners”;

1 (II) by striking “Commissioners’” each  
2 place it appears and inserting “Assistant Com-  
3 missioners’”; and

4 (iv) in subparagraph (C), by striking “Commis-  
5 sioners” and inserting “Assistant Commissioners”.

6 (C) Section 3(f) of title 35, United States Code, is  
7 amended in paragraphs (2) and (3), by striking “the Com-  
8 missioner” each place it appears and inserting “the Assist-  
9 ant Commissioner”.

10 (D) Section 13 of title 35, United States Code, is  
11 amended—

12 (i) by striking “Commissioner of” each place it  
13 appears and inserting “Assistant Commissioner for”;  
14 and

15 (ii) by striking “Commissioners” and inserting  
16 “Assistant Commissioners”.

17 (E) Chapter 17 of title 35, United States Code, is  
18 amended by striking “Commissioner of Patents” each  
19 place it appears and inserting “Assistant Commissioner  
20 for Patents”.

21 (F) Section 297 of title 35, United States Code, is  
22 amended by striking “Commissioner of Patents” each  
23 place it appears and inserting “Commissioner”.

24 (4) Title 35, United States Code, is amended by  
25 striking “Commissioner for Trademarks” each place it ap-

1   pears and inserting “Assistant Commissioner for Trade-  
2   marks”.

3       (5) Section 5314 of title 5, United States Code, is  
4   amended by striking

5           “Under Secretary of Commerce for Intellectual  
6       Property and Director of the United States Patent  
7       and Trademark Office.”

8   and inserting

9           “Under Secretary of Commerce for Intellectual  
10      Property and Commissioner of the United States  
11      Patent and Trademark Office.”.

12      (6)(A) Section 303 of title 35, United States Code,  
13   is amended—

14           (i) in the section heading by striking “**Direc-**  
15      **tor** ” and inserting “**Commissioner**”; and

16           (ii) by striking “Director’s” and inserting  
17      “Commissioner’s”.

18      (B) The item relating to section 303 in the table of  
19   sections for chapter 30 of title 35, United States Code,  
20   is amended by striking “Director” and inserting “Com-  
21   missioner”.

22      (b) ADDITIONAL CLERICAL AMENDMENTS.—

23           (1) The following provisions of law are amended  
24      by striking “Director” each place it appears and in-  
25      serting “Commissioner”.

1 (A) Section 9(p)(1)(B) of the Small Busi-  
2 ness Act (15 U.S.C. 638(p)(1)(B)).

3 (B) Section 19 of the Tennessee Valley  
4 Authority Act of 1933 (16 U.S.C. 831r).

5 (C) Section 182(b)(2)(A) of the Trade Act  
6 of 1974 (19 U.S.C. 2242(b)(2)(A)).

7 (D) Section 302(b)(2)(D) of the Trade Act  
8 of 1974 (19 U.S.C. 2412(b)(2)(D)).

9 (E) Section 702(d) of the Federal Food,  
10 Drug, and Cosmetic Act (21 U.S.C. 372(d)).

11 (F) Section 1295(a)(4)(B) of title 28,  
12 United States Code.

13 (G) Section 1744 of title 28, United States  
14 Code.

15 (H) Section 151 of the Atomic Energy Act  
16 of 1954 (42 U.S.C. 2181).

17 (I) Section 152 of the Atomic Energy Act  
18 of 1954 (42 U.S.C. 2182).

19 (J) Section 305 of the National Aero-  
20 nautics and Space Act of 1958 (42 U.S.C.  
21 2457).

22 (K) Section 12(a) of the Solar Heating  
23 and Cooling Demonstration Act of 1974 (42  
24 U.S.C. 5510(a)).

1 (L) Section 10(i) of the Trading with the  
2 enemy Act (50 U.S.C. App. 10(i)).

3 (M) Section 4203 of the Intellectual Prop-  
4 erty and Communications Omnibus Reform Act  
5 of 1999, as enacted by section 1000(a)(9) of  
6 Public Law 106–113.

7 (2) The item relating to section 1744 in the  
8 table of sections for chapter 115 of title 28, United  
9 States Code, is amended by striking “generally” and  
10 inserting “, generally”.

11 (c) REFERENCES.—Any reference in any other Fed-  
12 eral law, Executive order, rule, regulation, or delegation  
13 of authority, or any document of or pertaining to the Pat-  
14 ent and Trademark Office—

15 (1) to the Director of the United States Patent  
16 and Trademark Office or to the Commissioner of  
17 Patents and Trademarks is deemed to refer to the  
18 Under Secretary of Commerce for Intellectual Prop-  
19 erty and Commissioner of the United States Patent  
20 and Trademark Office;

21 (2) to the Commissioner for Patents is deemed  
22 to refer to the Assistant Commissioner for Patents;  
23 and

1           (3) to the Commissioner for Trademarks is  
 2       deemed to refer to the Assistant Commissioner for  
 3       Trademarks.

4   **SEC. 3. CLARIFICATION OF REEXAMINATION PROCEDURE**  
 5                   **ACT OF 1999; TECHNICAL AMENDMENTS.**

6       (a) OPTIONAL INTER PARTES REEXAMINATION PRO-  
 7       CEDURES.—Title 35, United States Code, is amended as  
 8       follows:

9           (1) Section 311 is amended—

10               (A) in subsection (a), by striking “person”  
 11               and inserting “third-party requester”; and

12               (B) in subsection (c), by striking “Unless  
 13               the requesting person is the owner of the pat-  
 14               ent, the” and inserting “The”.

15           (2) Section 312 is amended—

16               (A) in subsection (a), by striking the last  
 17               sentence; and

18               (B) by striking “, if any”.

19           (3) Section 314(b)(1) is amended—

20               (A) by striking “(1) This” and all that fol-  
 21               lows through “(2)” and inserting “(1)”;

22               (B) by striking “the third-party requester  
 23               shall receive a copy” and inserting “the Office  
 24               shall send to the third-party requester a copy”;  
 25               and

1 (C) by redesignating paragraph (3) as  
2 paragraph (2).

3 (4) Section 315(c) is amended by striking  
4 “United States Code,”.

5 (5) Section 317 is amended—

6 (A) in subsection (a), by striking “patent  
7 owner nor the third-party requester, if any, nor  
8 privies of either” and inserting “third-party re-  
9 quester nor its privies”; and

10 (B) in subsection (b), by striking “United  
11 States Code,”.

12 (b) CONFORMING AMENDMENTS.—

13 (1) APPEAL TO THE BOARD OF PATENT AP-  
14 PEALS AND INTERFERENCES.—Subsections (a), (b),  
15 and (c) of section 134 of title 35, United States  
16 Code, are each amended by striking “administrative  
17 patent judge” each place it appears and inserting  
18 “primary examiner”.

19 (2) PROCEEDING ON APPEAL.—Section 143 of  
20 title 35, United States Code, is amended by amend-  
21 ing the third sentence to read as follows: “In an ex  
22 parte case or any reexamination case, the Commis-  
23 sioner shall submit to the court in writing the  
24 grounds for the decision of the Patent and Trade-  
25 mark Office, addressing all the issues involved in the



1 appeal. The court shall, before hearing an appeal,  
 2 give notice of the time and place of the hearing to  
 3 the Commissioner and the parties in the appeal.”.

4 (c) CLERICAL AMENDMENTS.—

5 (1) Section 4604(a) of the Intellectual Property  
 6 and Communications Omnibus Reform Act of 1999,  
 7 is amended by striking “Part 3” and inserting “Part  
 8 III”.

9 (2) Section 4604(b) of that Act is amended by  
 10 striking “title 25” and inserting “title 35”.

11 (d) EFFECTIVE DATE.—The amendments made by  
 12 sections 4605(c) and 4605(e) of the Intellectual Property  
 13 and Communications Omnibus Reform Act, as enacted by  
 14 section 1000(a)(9) of Public Law 106–113, shall apply to  
 15 any reexamination filed in the United States Patent and  
 16 Trademark Office on or after the date of the enactment  
 17 of Public Law 106–113.

18 **SEC. 4. PATENT AND TRADEMARK EFFICIENCY ACT AMEND-**  
 19 **MENTS.**

20 (a) DEPUTY COMMISSIONER.—

21 (1) Section 17(b) of the Act of July 5, 1946  
 22 (commonly referred to as the “Trademark Act of  
 23 1946”) (15 U.S.C. 1067(b)), is amended by insert-  
 24 ing “the Deputy Commissioner,” after “Commis-  
 25 sioner,”.

1           (2) Section 6(a) of title 35, United States Code,  
 2       is amended by inserting “the Deputy Commis-  
 3       sioner,” after “Commissioner,”.

4       (b) PUBLIC ADVISORY COMMITTEES.—Section 5 of  
 5 title 35, United States Code, is amended—

6           (1) in subsection (i), by inserting “, privileged,”  
 7       after “personnel”; and

8           (2) by adding at the end the following new sub-  
 9       section:

10       “(j) INAPPLICABILITY OF PATENT PROHIBITION.—  
 11 Section 4 shall not apply to voting members of the Advi-  
 12 sory Committees.”.

13       (c) MISCELLANEOUS.—Section 153 of title 35,  
 14 United States Code, is amended by striking “and attested  
 15 by an officer of the Patent and Trademark Office des-  
 16 ignated by the Commissioner,”.

17 **SEC. 5. DOMESTIC PUBLICATION OF FOREIGN FILED PAT-**  
 18 **ENT APPLICATIONS ACT OF 1999 AMEND-**  
 19 **MENTS.**

20       Section 154(d)(4)(A) of title 35, United States Code,  
 21 as in effect on November 29, 2000, is amended—

22           (1) by striking “on which the Patent and  
 23 Trademark Office receives a copy of the” and insert-  
 24 ing “of”; and

1           (2) by striking “international application” the  
2           last place it appears and inserting “publication”.

3   **SEC. 6. DOMESTIC PUBLICATION OF PATENT APPLICA-**  
4                           **TIONS PUBLISHED ABROAD.**

5           Subtitle E of title IV of the Intellectual Property and  
6   Communications Omnibus Reform Act of 1999, as enacted  
7   by section 1000(a)(9) of Public Law 106–113, is amended  
8   as follows:

9           (1) Section 4505 is amended to read as follows:

10   **“SEC. 4505. PRIOR ART EFFECT OF PUBLISHED APPLICA-**  
11                           **TIONS.**

12           “Section 102(e) of title 35, United States Code, is  
13   amended to read as follows:

14           “(e) the invention was described in (1) an applica-  
15   tion for patent, published under section 122(b), by another  
16   filed in the United States before the invention by the ap-  
17   plicant for patent or (2) a patent granted on an applica-  
18   tion for patent by another filed in the United States before  
19   the invention by the applicant for patent, except that an  
20   international application filed under the treaty defined in  
21   section 351(a) shall have the effects for the purposes of  
22   this subsection of an application filed in the United States  
23   if and only if the international application designated the  
24   United States and was published under Article 21(2) of  
25   such treaty in the English language; or’ ”.

1 (2) Section 4507 is amended—

2 (A) in paragraph (1), by striking “Section  
3 11” and inserting “Section 10”;

4 (B) in paragraph (2), by striking “Section  
5 12” and inserting “Section 11”.

6 (C) in paragraph (3), by striking “Section  
7 13” and inserting “Section 12”;

8 (D) in paragraph (4), by striking “12 and  
9 13” and inserting “11 and 12”;

10 (E) in section 374 of title 35, United  
11 States Code, as amended by paragraph (10), by  
12 striking “confer the same rights and shall have  
13 the same effect under this title as an applica-  
14 tion for patent published” and inserting “be  
15 deemed a publication”; and

16 (F) by adding at the end the following:

17 “(12) The item relating to section 374 in the  
18 table of contents for chapter 37 of title 35, United  
19 States Code, is amended to read as follows:

“374. Publication of international application.”.

20 (3) Section 4508 is amended to read as follows:

21 **“SEC. 4508. EFFECTIVE DATE.**

22 “Except as otherwise provided in this section, sec-  
23 tions 4502 through 4507, and the amendments made by  
24 such sections, shall take effect on November 29, 2000, and  
25 shall apply only to applications (including international

1 applications designating the United States) filed on or  
 2 after that date. The amendments made by sections 4504  
 3 and 4505 shall additionally apply to any pending applica-  
 4 tion filed before November 29, 2000, if such pending ap-  
 5 plication is published pursuant to a request of the appli-  
 6 cant under such procedures as may be established by the  
 7 Commissioner. If an application is filed on or after No-  
 8 vember 29, 2000, or is published pursuant to a request  
 9 from the applicant, and the application claims the benefit  
 10 of one or more prior-filed applications under section  
 11 119(e), 120, or 365(c) of title 35, United States Code,  
 12 then the amendment made by section 4505 shall apply to  
 13 the prior-filed application in determining the filing date  
 14 in the United States of the application.”.

15 **SEC. 7. MISCELLANEOUS CLERICAL AMENDMENTS.**

16 (a) AMENDMENTS TO TITLE 35.—The following pro-  
 17 visions of title 35, United States Code, are amended:

18 (1) Section 2(b) is amended in paragraphs

19 (2)(B) and (4)(B), by striking “, United States  
 20 Code”.

21 (2) Section 3 is amended—

22 (A) in subsection (a)(2)(B), by striking  
 23 “United States Code,”;

24 (B) in subsection (b)(2)—

1 (i) in the first sentence of subpara-  
 2 graph (A), by striking “, United States  
 3 Code”;

4 (ii) in the first sentence of subpara-  
 5 graph (B)—

6 (I) by striking “United States  
 7 Code,”; and

8 (II) by striking “, United States  
 9 Code”;

10 (iii) in the second sentence of sub-  
 11 paragraph (B)—

12 (I) by striking “United States  
 13 Code,”; and

14 (II) by striking “, United States  
 15 Code.” and inserting a period;

16 (iv) in the last sentence of subpara-  
 17 graph (B), by striking “, United States  
 18 Code”; and

19 (v) in subparagraph (C), by striking  
 20 “, United States Code”; and  
 21 (C) in subsection (c)—

22 (i) in the subsection caption, by strik-  
 23 ing “, UNITED STATES CODE”; and

24 (ii) by striking “United States Code,”.

1           (3) Section 5 is amended in subsections (e) and  
 2           (g), by striking “, United States Code” each place  
 3           it appears.

4           (4) The table of chapters for part I is amended  
 5           in the item relating to chapter 3, by striking “**be-**  
 6           **fore**” and inserting “**Before**”.

7           (5) The item relating to section 21 in the table  
 8           of contents for chapter 2 is amended to read as fol-  
 9           lows:

“21. Filing date and day for taking action.”.

10           (6) The item relating to chapter 12 in the table  
 11           of chapters for part II is amended to read as fol-  
 12           lows:

**“12. Examination of Application ..... 131”.**

13           (7) The item relating to section 116 in the table  
 14           of contents for chapter 11 is amended to read as fol-  
 15           lows:

“116. Inventors.”.

16           (8) Section 154(b)(4) is amended by striking “,  
 17           United States Code,”.

18           (9) Section 156 is amended—

19                   (A) in subsection (b)(3)(B), by striking  
 20                   “paragraphs” and inserting “paragraph”;

21                   (B) in subsection (d)(2)(B)(i), by striking  
 22                   “below the office” and inserting “below the Of-  
 23                   fice”; and

1 (C) in subsection (g)(6)(B)(iii), by striking  
2 “submittted” and inserting “submitted”.

3 (10) The item relating to section 183 in the  
4 table of contents for chapter 17 is amended by strik-  
5 ing “of” and inserting “to”.

6 (11) Section 185 is amended by striking the  
7 second period at the end of the section.

8 (12) Section 201(a) is amended—

9 (A) by striking “United States Code,”; and

10 (B) by striking “5, United States Code.”  
11 and inserting “5.”.

12 (13) Section 202 is amended—

13 (A) in subsection (b)(4), by striking “last  
14 paragraph of section 203(2)” and inserting  
15 “section 203(b)”;

16 (B) in subsection (c)—

17 (i) in paragraph (4) by striking  
18 “rights;” and inserting “rights,”; and

19 (ii) in paragraph (5) by striking “of  
20 the United States Code”.

21 (14) Section 203 is amended—

22 (A) in paragraph (2)—

23 (i) by striking “(2)” and inserting  
24 “(b)”;



1 (ii) by striking the quotation marks  
2 and comma before “as appropriate”; and

3 (iii) by striking “paragraphs (a) and  
4 (c)” and inserting “paragraphs (1) and (3)  
5 of subsection (a)”; and

6 (B) in the first paragraph—

7 (i) by striking “(a)”, “(b)”, “(c)”,  
8 and (d)” and inserting “(1)”, “(2)”, “(3)”,  
9 and (4)”, respectively; and

10 (ii) by striking “(1.” and inserting  
11 “(a)”.

12 (15) Section 209 is amended in subsections (a)  
13 and (f)(1), by striking “of the United States Code”.

14 (16) Section 210 is amended—

15 (A) in subsection (a)—

16 (i) in paragraph (11), by striking  
17 “5901” and inserting “5908”; and

18 (ii) in paragraph (20) by striking  
19 “178(j)” and inserting “178j”; and

20 (B) in subsection (c)—

21 (i) by striking “paragraph 202(c)(4)”  
22 and inserting “section 202(c)(4)”; and

23 (ii) by striking “title.” and inserting  
24 “title.”.

1           (17) The item relating to chapter 29 in the  
 2           table of chapters for part III is amended by insert-  
 3           ing a comma after “**Patent**”.

4           (18) The item relating to section 256 in the  
 5           table of contents for chapter 25 is amended to read  
 6           as follows:

“256. Correction of named inventor.”.

7           (19) Section 294 is amended—

8                   (A) in subsection (b), by striking “United  
 9                   States Code,”; and

10                   (B) in subsection (c), in the second sen-  
 11                   tence by striking “court to” and inserting  
 12                   “court of”.

13           (20)(A) The item relating to section 374 in the  
 14           table of contents for chapter 37 is amended to read  
 15           as follows:

“374. Publication of international application.”.

16                   (B) The amendment made by subparagraph (A)  
 17                   shall take effect on November 29, 2000.

18           (21) Section 371(b) is amended by adding at  
 19           the end a period.

20           (22) Section 371(d) is amended by adding at  
 21           the end a period.

22           (23) Paragraphs (1), (2), and (3) of section  
 23           376(a) are each amended by striking the semicolon  
 24           and inserting a period.

1 (b) OTHER AMENDMENTS.—

2 (1) Section 4732(a) of the Intellectual Property  
3 and Communications Omnibus Reform Act of 1999  
4 is amended—

5 (A) in paragraph (9)(A)(ii), by inserting  
6 “in subsection (b),” after “(ii)”; and

7 (B) in paragraph (10)(A), by inserting  
8 after “title 35, United States Code,” the fol-  
9 lowing: “other than sections 1 through 6 (as  
10 amended by chapter 1 of this subtitle),”.

11 (2) Section 4802(1) of that Act is amended by  
12 inserting “to” before “citizens”.

13 (3) Section 4804 of that Act is amended—

14 (A) in subsection (b), by striking “11(a)”  
15 and inserting “10(a)”; and

16 (B) in subsection (c), by striking “13” and  
17 inserting “12”.

18 (4) Section 4402(b)(1) of that Act is amended  
19 by striking “in the fourth paragraph”.

20 **SEC. 8. TECHNICAL CORRECTIONS IN TRADEMARK LAW.**

21 (a) AWARD OF DAMAGES.—Section 35(a) of the Act  
22 of July 5, 1946 (commonly referred to as the “Trademark  
23 Act of 1946”) (15 U.S.C. 1117(a)), is amended by strik-  
24 ing “a violation under section 43(a), (c), or (d),” and in-  
25 serting “a violation under section 43(a) or (d),”.

1 (b) ADDITIONAL TECHNICAL AMENDMENTS.—The  
2 Trademark Act of 1946 is further amended as follows:

3 (1) Section 1(d)(1) (15 U.S.C. 1051(d)(1)) is  
4 amended in the first sentence by striking “specifying  
5 the date of the applicant’s first use” and all that fol-  
6 lows through the end of the sentence and inserting  
7 “specifying the date of the applicant’s first use of  
8 the mark in commerce and those goods or services  
9 specified in the notice of allowance on or in connec-  
10 tion with which the mark is used in commerce.”.

11 (2) Section 1(e) (15 U.S.C. 1051(e)) is amend-  
12 ed to read as follows:

13 “(e) If the applicant is not domiciled in the United  
14 States the applicant may designate, by a document filed  
15 in the United States Patent and Trademark Office, the  
16 name and address of a person resident in the United  
17 States on whom may be served notices or process in pro-  
18 ceedings affecting the mark. Such notices or process may  
19 be served upon the person so designated by leaving with  
20 that person or mailing to that person a copy thereof at  
21 the address specified in the last designation so filed. If  
22 the person so designated cannot be found at the address  
23 given in the last designation, or if the registrant does not  
24 designate by a document filed in the United States Patent  
25 and Trademark Office the name and address of a person

1 resident in the United States on whom may be served no-  
2 tices or process in proceedings affecting the mark, such  
3 notices or process may be served on the Commissioner.”;

4 (3) Section 8(f) (15 U.S.C. 1058(f)) is amend-  
5 ed to read as follows:

6 “(f) If the registrant is not domiciled in the United  
7 States, the registrant may designate, by a document filed  
8 in the United States Patent and Trademark Office, the  
9 name and address of a person resident in the United  
10 States on whom may be served notices or process in pro-  
11 ceedings affecting the mark. Such notices or process may  
12 be served upon the person so designated by leaving with  
13 that person or mailing to that person a copy thereof at  
14 the address specified in the last designation so filed. If  
15 the person so designated cannot be found at the address  
16 given in the last designation, or if the registrant does not  
17 designate by a document filed in the United States Patent  
18 and Trademark Office the name and address of a person  
19 resident in the United States on whom may be served no-  
20 tices or process in proceedings affecting the mark, such  
21 notices or process may be served on the Commissioner.”;

22 (4) Section 9(c) (15 U.S.C. 1059(c)) is amend-  
23 ed to read as follows:

24 “(c) If the registrant is not domiciled in the United  
25 States the registrant may designate, by a document filed

1 in the United States Patent and Trademark Office, the  
 2 name and address of a person resident in the United  
 3 States on whom may be served notices or process in pro-  
 4 ceedings affecting the mark. Such notices or process may  
 5 be served upon the person so designated by leaving with  
 6 that person or mailing to that person a copy thereof at  
 7 the address specified in the last designation so filed. If  
 8 the person so designated cannot be found at the address  
 9 given in the last designation, or if the registrant does not  
 10 designate by a document filed in the United States Patent  
 11 and Trademark Office the name and address of a person  
 12 resident in the United States on whom may be served no-  
 13 tices or process in proceedings affecting the mark, such  
 14 notices or process may be served on the Commissioner.”;

15 (5) Subsections (a) and (b) of section 10 (15  
 16 U.S.C. 1060(a) and (b)) are amended to read as fol-  
 17 lows:

18 “(a)(1) A registered mark or a mark for which an  
 19 application to register has been filed shall be assignable  
 20 with the good will of the business in which the mark is  
 21 used, or with that part of the good will of the business  
 22 connected with the use of and symbolized by the mark.  
 23 Notwithstanding the preceding sentence, no application to  
 24 register a mark under section 1(b) shall be assignable  
 25 prior to the filing of an amendment under section 1(c)

1 to bring the application into conformity with section 1(a)  
2 or the filing of the verified statement of use under section  
3 1(d), except for an assignment to a successor to the busi-  
4 ness of the applicant, or portion thereof, to which the  
5 mark pertains, if that business is ongoing and existing.

6 “(2) In any assignment authorized by this section,  
7 it shall not be necessary to include the good will of the  
8 business connected with the use of and symbolized by any  
9 other mark used in the business or by the name or style  
10 under which the business is conducted.

11 “(3) Assignments shall be by instruments in writing  
12 duly executed. Acknowledgment shall be prima facie evi-  
13 dence of the execution of an assignment, and when the  
14 prescribed information reporting the assignment is re-  
15 corded in the United States Patent and Trademark Office,  
16 the record shall be prima facie evidence of execution.

17 “(4) An assignment shall be void against any subse-  
18 quent purchaser for valuable consideration without notice,  
19 unless the prescribed information reporting the assign-  
20 ment is recorded in the United States Patent and Trade-  
21 mark Office within 3 months after the date of the assign-  
22 ment or prior to the subsequent purchase.

23 “(5) The United States Patent and Trademark Office  
24 shall maintain a record of information on assignments, in  
25 such form as may be prescribed by the Commissioner.

1       “(b) An assignee not domiciled in the United States  
2 may designate by a document filed in the United States  
3 Patent and Trademark Office the name and address of  
4 a person resident in the United States on whom may be  
5 served notices or process in proceedings affecting the  
6 mark. Such notices or process may be served upon the  
7 person so designated by leaving with that person or mail-  
8 ing to that person a copy thereof at the address specified  
9 in the last designation so filed. If the person so designated  
10 cannot be found at the address given in the last designa-  
11 tion, or if the assignee does not designate by a document  
12 filed in the United States Patent and Trademark Office  
13 the name and address of a person resident in the United  
14 States on whom may be served notices or process in pro-  
15 ceedings affecting the mark, such notices or process may  
16 be served upon the Commissioner.”;

17           (7) Section 23(c) (15 U.S.C. 1091(c)) is  
18 amended by striking the second comma after “nu-  
19 meral”.

20           (8) Section 33(b)(8) (15 U.S.C. 1115(b)(8)) is  
21 amended by aligning the text with paragraph (7).

22           (9) Section 34(d)(1)(A) (15 U.S.C.  
23 1116(d)(1)(A)) is amended by striking “section  
24 110” and all that follows through “(36 U.S.C. 380)”



1 and inserting “section 220506 of title 36, United  
2 States Code,”.

3 (10) Section 34(d)(1)(B)(ii) (15 U.S.C.  
4 1116(d)(1)(B)(ii)) is amended by striking “section  
5 110” and all that follows through “(36 U.S.C. 380)”  
6 and inserting “section 220506 of title 36, United  
7 States Code”.

8 (11) Section 34(d)(11) is amended by striking  
9 “6621 of the Internal Revenue Code of 1954” and  
10 inserting “6621(a)(2) of the Internal Revenue Code  
11 of 1986”.

12 (12) Section 35(b) (15 U.S.C. 1117(b)) is  
13 amended—

14 (A) by striking “section 110” and all that  
15 follows through “(36 U.S.C. 380)” and insert-  
16 ing “section 220506 of title 36, United States  
17 Code,”; and

18 (B) by striking “6621 of the Internal Rev-  
19 enue Code of 1954” and inserting “6621(a)(2)  
20 of the Internal Revenue Code of 1986”.

21 (13) Section 44(e) (15 U.S.C. 1126(e)) is  
22 amended by striking “a certification” and inserting  
23 “a true copy, a photocopy, a certification,”.

1 **SEC. 9. PATENT AND TRADEMARK FEE CLERICAL AMEND-**  
 2 **MENT.**

3 The Patent and Trademark Fee Fairness Act of 1999  
 4 (113 Stat. 1537–546 et seq.), as enacted by section  
 5 1000(a)(9) of Public Law 106–113, is amended in section  
 6 4203, by striking “111(a)” and inserting “1113(a)”.

7 **SEC. 10. COPYRIGHT RELATED CORRECTIONS TO 1999 OM-**  
 8 **NIBUS REFORM ACT.**

9 Title I of the Intellectual Property and Communica-  
 10 tions Omnibus Reform Act of 1999, as enacted by section  
 11 1000(a)(9) of Public Law 106–113, is amended as follows:

12 (1) Section 1007 is amended—

13 (A) in paragraph (2), by striking “para-  
 14 graph (2)” and inserting “paragraph (2)(A)”;  
 15 and

16 (B) in paragraph (3), by striking  
 17 “1005(e)” and inserting “1005(d)”.

18 (2) Section 1006(b) is amended by striking  
 19 “119(b)(1)(B)(iii)” and inserting  
 20 “119(b)(1)(B)(ii)”.

21 (3)(A) Section 1006(a) is amended—

22 (i) in paragraph (1), by adding “and”  
 23 after the semicolon;

24 (ii) by striking paragraph (2); and

25 (iii) by redesignating paragraph (3) as  
 26 paragraph (2).

1 (B) Section 1011(b)(2)(A) is amended to read  
 2 as follows:

3 “(A) in paragraph (1), by striking ‘pri-  
 4 mary transmission made by a superstation and  
 5 embodying a performance or display of a work’  
 6 and inserting ‘performance or display of a work  
 7 embodied in a primary transmission made by a  
 8 superstation or by the Public Broadcasting  
 9 Service satellite feed’;”.

10 **SEC. 11. AMENDMENTS TO TITLE 17, UNITED STATES CODE.**

11 Title 17, United States Code, is amended as follows:

12 (1) Section 119(a)(6) is amended by striking  
 13 “of performance” and inserting “of a performance”.

14 (2)(A) The section heading for section 122 is  
 15 amended by striking “**rights; secondary**” and  
 16 inserting “**rights: Secondary**”.

17 (B) The item relating to section 122 in the  
 18 table of contents for chapter 1 is amended to read  
 19 as follows:

“122. Limitations on exclusive rights: Secondary transmissions by satellite car-  
 riers within local markets.”.

20 (3)(A) The section heading for section 121 is  
 21 amended by striking “**reproduction**” and insert-  
 22 ing “**Reproduction**”.

1           (B) The item relating to section 121 in the  
2           table of contents for chapter 1 is amended by strik-  
3           ing “reproduction” and inserting “Reproduction”.

4           (4)(A) Section 106 is amended by striking “107  
5           through 121” and inserting “107 through 122”.

6           (B) Section 501(a) is amended by striking “106  
7           through 121” and inserting “106 through 122”.

8           (C) Section 511(a) is amended by striking “106  
9           through 121” and inserting “106 through 122”.

10          (5) Section 101 is amended—

11               (A) by moving the definition of “computer  
12               program” so that it appears after the definition  
13               of “compilation”; and

14               (B) by moving the definition of “registra-  
15               tion” so that it appears after the definition of  
16               “publicly”.

17          (6) Section 110(4)(B) is amended in the matter  
18          preceding clause (i) by striking “conditions;” and in-  
19          serting “conditions:”.

20          (7) Section 118(b)(1) is amended in the second  
21          sentence by striking “to it”.

22          (8) Section 119(b)(1)(A) is amended—

23               (A) by striking “transmitted” and insert-  
24               ing “retransmitted”; and

1 (B) by striking “transmissions” and insert-  
2 ing “retransmissions”.

3 (9) Section 203(a)(2) is amended—

4 (A) in subparagraph (A)—

5 (i) by striking “(A) the” and inserting  
6 “(A) The”; and

7 (ii) by striking the semicolon at the  
8 end and inserting a period;

9 (B) in subparagraph (B)—

10 (i) by striking “(B) the” and inserting  
11 “(B) The”; and

12 (ii) by striking the semicolon at the  
13 end and inserting a period; and

14 (C) in subparagraph (C), by striking “(C)  
15 the” and inserting “(C) The”.

16 (10) Section 304(c)(2) is amended—

17 (A) in subparagraph (A)—

18 (i) by striking “(A) the” and inserting  
19 “(A) The”; and

20 (ii) by striking the semicolon at the  
21 end and inserting a period;

22 (B) in subparagraph (B)—

23 (i) by striking “(B) the” and inserting  
24 “(B) The”; and

1 (ii) by striking the semicolon at the  
2 end and inserting a period; and

3 (C) in subparagraph (C), by striking “(C)  
4 the” and inserting “(C) The”.

5 (11) The item relating to section 903 in the  
6 table of contents for chapter 9 is amended by strik-  
7 ing “licensure” and inserting “licensing”.

8 **SEC. 12. OTHER COPYRIGHT RELATED TECHNICAL AMEND-**  
9 **MENTS.**

10 (a) AMENDMENT TO TITLE 18.—Section 2319(e)(2)  
11 of title 18, United States Code, is amended by striking  
12 “107 through 120” and inserting “107 through 122”.

13 (b) STANDARD REFERENCE DATA.—(1) Section  
14 105(f) of Public Law 94–553 is amended by striking “sec-  
15 tion 290(e) of title 15” and inserting “section 6 of the  
16 Standard Reference Data Act (15 U.S.C. 290e)”.

17 (2) Section 6(a) of the Standard Reference Data Act  
18 (15 U.S.C. 290e) is amended by striking “Notwith-  
19 standing” and all that follows through “United States  
20 Code,” and inserting “Notwithstanding the limitations  
21 under section 105 of title 17, United States Code,”.



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1ST SESSION

**S. 320**

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**A BILL**

To make technical corrections in patent, copyright,  
and trademark laws.

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FEBRUARY 13, 2001

Read twice and ordered placed on the calendar